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JF

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/574,987 05/12/00 BECKER C 82408

EXAMINER

IM22/1030

COMMANDING OFFICE
OFFICE OF PATENT COUNSEL CODE D0012
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ART UNIT

PAPER NUMBER

1741

DATE MAILED:

10/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/574,987

Applicant(s)
Becker, Carol

Examiner
Thao Tran

Art Unit
1741



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Aug 9, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 7-13 and 31-38 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 7-13 and 31-38 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____

Art Unit: 1741

DETAILED ACTION

Response to Amendment

1. This is in response to the Amendments received on August 9, 2001. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
2. Claims 7-13 and 27-38 are currently pending in this application. Claim 14 has been canceled. Claims 34-38 have been newly added.

Claim Objections

3. In view of the prior Office Action of May 7, 2001, the objection to claim 27 has been withdrawn.
4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 37, first occurrence, has been renumbered claim 34.

Art Unit: 1741

Claim Rejections - 35 USC § 102

5. Claims 7-13 and 27-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Zirino (US Pat. 5,334,629).

The rejection of claims 7-13 and 27-33 is as set forth in the prior Office Action of May 7, 2001.

In regards to claim 34, the arguments are as presented in claims 7-8 in the prior Office Action of May 7, 2001. Applicant is reminded that the material to be worked upon, not the physical structure, has been held insufficient to patentably distinct over prior art when an apparatus claim is being considered for its patentability. See *In re Young*, 25 USPQ 69 (CCPA 1935); *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969); *In re Casey*, 370 F. 2d 576, 152 USPQ 235 (CCPA 1967).

In regards to claim 35, the arguments are as presented in claim 9 in the prior Office Action of May 7, 2001.

In regards to claim 37, the arguments are as presented in claims 1 and 12 in the prior Office Action of May 7, 2001. See paragraph in claim 34.

In regards to claim 36 and 38, the arguments are as presented in claim 27 in the prior Office Action of May 7, 2001.

Application/Control Number: 09/574,987

Art Unit: 1741

Response to Arguments

On page 5 of applicant's response, applicant contends that Zirino does not teach an apparatus utilizing a solution of anthracene. Applicant's contention is correct. However, as mentioned in the prior Office Action of May 7, 2001 and in paragraph 5 above, the material to be worked upon, not the physical structure, has been held insufficient to patentably distinct over prior art when an apparatus claim is being considered.

On page 6 of applicant's response, "applicant traverses the 'apparatus' as made by the examiner" by citing *In re Young*. The examiner agrees to applicant that Young's claims were rejected on the ground that inclusion of the article formed within the body of the claim did not make the claim patentable over prior art and therefore "the Patent Office rejected all of Young's claims". Thus, the solution containing anthracene and the polymer disposed in the solution as claimed do not make the instant claims patentably distinct over prior art.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Application/Control Number: 09/574,987


Art Unit: 1741

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao Tran whose telephone number is (703) 306-5698. The examiner can normally be reached on Monday-Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathryn Gorgos, can be reached on (703) 308-3328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Kathryn Gorgos
Supervisory Patent Examiner
Technology Center 1700

T.T.

October 26, 2001